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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,839	02/14/2001	Jean-Marie Gatto	CYBS5747	1619

22430 7590 06/04/2003
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EXAMINER

SANDERS, ALLYSON N

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,839

Applicant(s)

GATTO ET AL.

Examiner

Allyson N Sanders

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the Response filed March 7, 2003.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 5, 6, 12, 14, 16, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Jung (6,147,777).

Regarding claim 1: A document image scanner, comprising: a feed roller; an image sensor adapted to sense an image of a document inserted in the scanner while pressing the document against the feed roller; and a printer adapted to print an indicium on the document while pressing the document against the feed roller is disclosed.

Jung teaches the following in regards to claim 1:

"The present invention relates to a combined machine for printing and scanning having a head assembly including a printer module and a scanner module..." (Col. 1, lines 15-17).

"To achieve these and other objects, a process and a combined machine for printing and scanning is provided. The combined machine includes: a printing unit printing images onto a printing medium; a scanning unit for scanning data from a document; a driving unit reciprocally moving the printing unit and the scanning unit in a predetermined section; a guiding unit guiding the printing unit and the scanning unit during the reciprocal movement in the predetermined section; a feeding unit supplying the printing medium or document; and an irradiating unit for irradiating light onto the printing medium or document over the whole area where the reciprocation is performed." (Col. 2 and 3 lines, 57-1).

"Turning now to FIG. 4, a combined machine having a head assembly including printer and scanner modules includes: a head assembly 100 with a printer module 110 for performing the printing operation of forming images and symbols onto a printable medium by spraying ink on print medium 120;" (Col. 4, lines 17-22).

"When the scanner module 130 of the head assembly 100 performs the reciprocation motion following the guiding shaft 150, the reflected light 304 from the document is received by an image pickup device 210 through a scanner glass 131 and a lens 220." (Col. 5, lines 5-10).

Regarding claims 3 and 14: The document scanner of claims 1 and 12 respectively, wherein the feed roller is adapted to feed the document to both the image sensor and to the printer is disclosed.

Jung teaches the following in regards to claims 3 and 14:

"Referring also to FIG. 2, when the head assembly 10 is moved to right and left, a lamp 23 inside of scanner module 13 irradiates light onto the document. The reflected light from the surface of the document 12 is received by an image pickup device 21 through a scanner glass (not illustrated) and a lens 22." (Col. 4, lines 1-6).

Fig. 2 discloses the feed roller (14) feeding the document (12), through the head assembly (10), which contains both the printing head (11) and the image pickup device or the image sensor (21).

Regarding claims 5 and 16: The document scanner of claims 1 and 12 respectively, wherein the printer includes a thermal print head is disclosed.

Jung teaches the following in regards to claims 5 and 16:

"The head assembly also includes a thermal print head." (Col. 1, lines 44-45).

Regarding claim 10: A method of capturing an image of a document and branding the document, comprising the steps of: scanning the image of the document while pressing the document against a feed roller; and branding the document by printing an indicium thereon while pressing the document against the feed roller is disclosed.

The method of scanning the image of the document while pressing the document against a feed roller is disclosed above. (See Jung's teachings in regards to claim 1). Additionally, Jung teaches branding the document by printing indicium thereon.

"The print head is located on the opposite side of the carriage, and, with an ink-fed stylus, imprints indicia on recording papers advanced by a different platen than that which advances the document to be scanned." (Col. 2, lines 25-28).

Regarding claims 6 and 17: The document scanner of claim 1, wherein the printer includes a print head that is wider than the document inserted in the document scanner is disclosed.

Jung teaches the following in regards to claims 6 and 17:

Figure 1, which shows the print head being as wide as the document.

Regarding claim 12: A document image scanner, comprising a feed roller, an image sensor and a printer, wherein both the image sensor and the printer apply pressure against the feed roller when the printer is in operation is disclosed.

The limitations disclosed in claim 12 are taught by Jung. See Jung's teachings in regards to claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 7, 8, 13, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung (6,147,777) in view of Gluck et al (4,855,756).

Jung's teachings are discussed above.

Jung fails to teach the printer being adapted to selectively assume a printing position in which the printer is positioned to print the indicium on the document and a non-printing position away from the printing position.

Regarding claims 2 and 13: The document scanner of claims 1 and 12 respectively, wherein the printer is adapted to selectively assume a printing position in which the printer is positioned to print the indicium on the document and a non-printing position away from the printing position is disclosed.

Gluck et al teaches the following in regards to claims 2 and 13:

The first printhead 30 transfers the outline of indicia pattern, or indicia pattern, as the case may be, from the length of ribbon 48 being fed to the second printing station 42 (FIG. 3), to the length of ribbon 48 being fed about the printhead backing roller 58. Then the first printhead 30 commences removing all of the ink (FIG. 17) from the length of ribbon 48 being fed to the second printing station 42 (FIG. 3), thereby "blanking" the ribbon 48. While printing is in progress at the first printing station 40, the ribbon 48 advances to the second printing station 42, as does the letter 70. Moreover, the leading edge of the letter 70 enters the second printing station 42 before indicia printing is completed at the first printing station 40 (FIGS. 3 and 17). Accordingly, prior to completion of printing at the first printing station 40, the microcomputer IC timely causes the second printhead 32 to be moved from its non-printing to printing position and to

commence transfer printing of the indicia pattern remaining on the ribbon 48 to the letter 70. Preferably such printing commences a predetermined marginal distance "d" (FIGS. 9 and 17) from the leading edge of the letter 70. Whereupon the indicia or outline of indicia pattern remaining on the ribbon 48 at the second printing station 42 is transferred in its entirety to the letter 70 as the letter 70 is fed through the second printing station 42. Upon completion of indicia printing at the second printing station 42, the CPU, in response to the printing cycle count, causes both printheads 30 and 32 to cease printing, followed by the CPU causing the second printhead 32 to be moved from its printing to non-printing position. Whereupon, the microcomputer terminates the printing cycle count.

Regarding claims 7 and 18: The document image scanner of claims 2 and 12 respectively, wherein the printer is pivotally coupled to a hinge and wherein the document is caused to at least partially wrap around the feed roller when the printer is pivoted to the printing position is disclosed.

Gluck et al teaches the following in regards to claims 7 and 18:

Preferably, the printhead 32, is conventionally pivoted at the midpoint thereof to the other end of the shaft 90, and a leaf spring 104 is connected between the shoulder 91 of the shaft 90 and the printhead 32 for resiliently constraining pivotal movement of the printhead 32 relative to the shaft 90." (Col. 7, lines 38-43).

Regarding claims 8 and 19: The document image scanner of claims 2 and 12 respectively, wherein the printer is pivotally coupled to a hinge and wherein the

document is substantially tangent to an outer surface of the feed roller when the printer is pivoted to the non-printing position is disclosed.

Gluck et al teaches the following in regards to claims 8 and 19:

FIG. 3, which is a diagrammatic view of a thermal ribbon cassette as positioned within the postage meter of the machine of FIG. 1.

In view of Gluck et al's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to have the printer be pivotally couple to a hinge and have the printer selectively assume a printing position for printing and a non-printing position which is away from the printing position. One would be motivated to have both a printing and non-printing position in order to be able to indicate when indicium will be printed on the scanned document.

6. Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung (6,147,777) in view of Lee (6,236,471).

Jung's teachings are discussed above.

Jung fails to specifically teach the image sensor including a contact image sensor.

Regarding claims 4 and 15: The document scanner of claims 1 and 12 respectively, wherein the image sensor includes a contact image sensor (CIS) is disclosed.

Lee teaches the following in regards to claims 4 and 15:

"A conventional scanner is designed to convert images recorded on a document into a computer-compatible electronic form. The images recorded on the document can

be scanned as follows. An amount of light is first transmitted to the document from a source. As a result, the image data on the document causes some of that light to be reflected in a particular pattern. The pattern of reflected light is then supplied to a fixed array of light sensors through an intermediate image reduction mirror. The light sensors in the array can be charge-coupled devices (CCD) or contact image sensors (CIS).” (Col. 1, lines 46-56).

In view of Lee’s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the sensors taught by Lee. Contact image sensors are commonly used in the art and one would be motivated to use CISs because they are so commonly used and are known to be effective and reliable.

7. Claims 9, 11, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung (6,147,777) in view of Ehrhart et al (6,419,157).

Jung’s teachings are discussed above.

Jung fails to teach making the initially machine readable marking unreadable by printing indicia on the marking.

Ehrhart teaches the following in regards to claims 9, 11, and 20:

Regarding claims 9 and 20: The document scanner of claims 1 and 13 respectively, wherein the document includes an initially machine readable marking thereon and wherein the indicia printed by the printer renders the marking unreadable is disclosed.

As shown in FIG. 4-2, game ticket 202 may have brandable ink formed thereon in accordance with the configuration described in U.S. Pat. No. 5,109,153 to Johnsen et al., incorporated herein by reference. Johnsen et al. describe a lottery game ticket, or another document, which includes a machine readable bar code symbol. According to Johnsen et al., brandable material is formed directly on the bar code symbol at such a location that when the material is branded, the machine readable code is rendered unreadable.

Regarding claim 11: The method of claim 10, wherein the document is a gaming ticket that includes an initially machine readable marking thereon and wherein the branding step renders the marking unreadable is disclosed.

Ehrhart teaches the limitation taught in claim 11. (See Ehrhart's teachings in regards to claim 9).

In view of Ehrhart's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to mark the initially machine readable marking unreadable by printing indicia on the marking. One would be motivated to make the marking unreadable in order to assure that the gaming ticket cannot be used more than once.

Response to Arguments

8. Applicant's arguments filed March 7, 2003 have been fully considered. The arguments regarding Jung have been considered, but they are not persuasive.

In response to the applicants arguments that Jung does not teach or suggest the claimed structure and more specifically that Jung does not teach the printer nor the scanner ever pressing the document against the feed roller or applying pressure against the feed roller, the examiner advises the applicant that given the broadest interpretation of the claim, the claim does not state that either the scanner or the printer press the document against the feed roller and therefor Jung does meet the claimed limitations. The claim only specifically states that an image sensor is adapted to sense an image of a document inserted in the scanner while pressing the document against the feed roller. Given the broadest interpretation, the claim only discloses the pressing of the document against the feed roller and not the scanner. The same applies to the printer. The claim does not disclose the printer pressing the document. The claim only discloses the function of the printer and the scanner occurring when the document is pressing against the feed roller. The limitation of the document pressing against the feed roller can be found in Jung's figure 2. The document (12) is feed with the rods of the feed rollers (14). Although Jung does not specifically state the feed rollers applying pressure to the document, it is obvious that in order to feed the document through the printing and scanning head, the feed roller must physically push the document through. It is only possible for the document to be pushed through by the feed roller if the feed roller is actually pressing against the document.

The examiner believes that Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims

patentably distinguishes them from the references. Moreover, given its broadest reasonable interpretation of the instant claims, Jung, Gluck et al, Lee, and Ehrhart et al, taken alone or in combination, meets the claimed invention.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson Sanders* whose telephone number is (703) 305-5779. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax phone number for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[allyson.sanders@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Allyson Sanders
Patent Examiner
Art Unit 2876
May 21, 2003


DIANE I. LEE
PRIMARY EXAMINER